



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/821,200

04/09/2004

Gerald P. Schatten

48631-00004

8230

7590 07/24/2007
Sheppard Mullin Richter & Hampton LLP
1300 I Street NW
11th Floor
Washington, DC 20005-3314

EXAMINER

TON, THAIAN N

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

07/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/821,200

Applicant(s)

SCHATTEN ET AL.

Examiner

Thaian N. Ton

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-16, 21 and 85.
Claim(s) withdrawn from consideration: 22, 23, 28-49 and 67-84.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 7/16/07
13. ☐ Other: _____


THAIAN N. TON
PATENT EXAMINER

Continuation of 3. NOTE: Applicants have now added claim 86 which recites that the primate is a Rhesus monkey. This raises new issues that require further search and consideration..

Continuation of 11. does NOT place the application in condition for allowance because: MPEP 714.13 states that Applicants cannot, as a matter of right, amend any finally rejected claims, except when an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some way requires only cursory review by the examiner.

The amendments filed after final are not entered, therefore the prior rejections of record are maintained. The Examiner responds to Applicants' comments to the extent that they apply to the rejections of record.

Claims 1-16, 21 and 85 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 10, 34-53 of copending Application No. 11/003,006 in view of Campbell (of record). Applicants present no new arguments with regard to this rejection, accordingly, this rejection is maintained.

Claims 1-16, 21 and 85 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. With respect to Applicants' arguments that the term "viable primate embryo" does not require the production of a cloned animal, the Examiner responds that the interpretation of the term "viable primate embryo" is evaluated with regard to the as-filed disclosure. The Examiner states, on page 7-8 of the Final Office action, that the only contemplated uses of these viable primate embryos are in the context of producing cloned primates, or using these embryos to produce ES cells. However, Applicants' elected invention is directed to producing cloned animals, therefore the claims have been examined to the extent that they read upon the claimed invention. Applicants argue that the Examiner ignores the accepted meaning in the art of the term "viable" and provides a specific definition for this term. The Examiner responds that a "viable embryo" is interpreted in light of the specification, for its enabled uses. In particular, one of skill in the art would only recognize two uses in that are contemplated in the specification for a viable embryo, to produce cloned animals and to produce ES cells. Because Applicants' claimed invention reads only on cloned animals, there is no other contemplated, enabled use for these viable embryos. Furthermore, it is unclear what use an embryo that is simply "capable of living", as stated by Applicants', would have in the context of the claimed invention. This would not appear to be a contemplated use for the claimed embryos. With regard to Applicants' arguments that the Ng and Chen reference do not provide predictability in producing viable, primate embryos, with regard to the removal of mitotic spindles, the Examiner notes that these references are provided to show, that even post-filing, it would not be predictable to produce viable, primate embryos. The specification provides no specific guidance to overcome these unpredictabilities. Applicants provide Zhou et al. for evidence. Because Applicants' amendment is not entered, these arguments are moot. With regard to Applicants' proposed claim amendment to claim 1 (see page 11 of the Response), this is not considered, because the amendment is not entered. With regard to Applicants' arguments that the working example provides use of the invention with cells of a rhesus monkey, the Examiner states that the claimed invention is not enabled because the specification provides no guidance with regard to which of the molecular components that are instantly claimed (a centrosome protein, a centrosomal component from a sperm centrosome, a mitotic motor protein), or specific combinations of these components that would result in a viable primate embryo. The observation that the primate embryos produced by SCNT do not form functional spindles, or that the centrosomes are missing NuMA and HSET kinseins do not provide guidance to show that addition of these proteins would correct the defect. Thus, the specification does not provide guidance with regard to the claimed invention, and does not overcome any of the art-recognized unpredictabilities in the art. The additional limitation of claim 85 (see page 13 of Applicants' Response), with regard to particular donor cells, is noted, but the breadth of the claims encompass any type of donor cell, thus, the prior rejection of record is proper and maintained. Claim 86 is not considered, therefore, the Examiner does not respond to Applicants' remarks regarding this claim.

Claims 1-16, 21 and 85 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amendment is not entered, therefore this rejection is maintained.